

BEST AVAILABLE COPY

INVENTOR: Desai et al.

S/N 09/682,843

**REMARKS**

Claims 1-24 and 26-32 are pending in the current application. In the Office Action mailed August 5, 2004, the Examiner rejected claims 1, 3, 4, 7-9, 16-24, 26, and 31 under 35 U.S.C. §103(a) as being unpatentable over the publication titled "OMEGAMARKER® Temperature Test Kit" by OMEGA®, hereinafter OMEGAMARKER®, in view of Lundberg, Sr. et al. (USP 2,785,654) and further in view of Peterson (USP 1,603,713). Applicant appreciates the indication of allowability of claim 32 and the indication of the allowability of the subject matter of claims 2, 5, 6, 10-15, and 27-30 if amended to overcome the Examiner's objections.

Applicant has submitted draft amendments for the Examiner's consideration and has made several attempts to contact the Examiner to discuss the outstanding issues. However, to date the Examiner has not returned the undersigned calls. As such, Applicant has herein addressed each and every of the Examiner's objections and rejections of the claims.

Claims 2-6, 10-15, 22-24, and 26-30 were objected to because of certain informalities. The Examiner objected to claim 2 stating that "there is lack of antecedent basis in the specification for the housing having one annular ring, as stated by 'at least one' ring in line 3." The Examiner further states that "the specification and figures disclose that there are at least two rings." As the Examiner acknowledges that the specification and figures show two rings, and two rings necessarily includes at least one ring as called for in claim 2, there is no lack of antecedent basis for such a limitation. Accordingly, Applicant requests the withdrawal of the objection to claim 2.

The Examiner objected to claim 3 stating that "there is lack of antecedent basis in the specification for the housing having one resistance mechanism for one stick, as stated by a resistance mechanism having for 'at least one' stick in line 2" and that "[t]he specification and figures disclose that there are two resistance mechanism, one for each stick." As the Examiner acknowledges that the specification and figures show two resistance mechanisms, and two resistance mechanisms necessarily includes at least one resistance mechanism as called for in claim 3, there is no lack of antecedent basis for

INVENTOR: Desai et al.

S/N 09/682,843

such a limitation. Accordingly, Applicant requests the withdrawal of the objection to claim 3.

The Examiner objected to claim 5 stating that "it is not clear how 'each of the pair of extension mechanisms' comprises more than one collet, as stated by the phrase 'at least one collet' in lines 2-3." Applicant has amended claim 5 to call for, in part, wherein each extension mechanism of the pair of extension mechanisms further comprises at least one collet. At least one includes one. Accordingly, Applicant requests withdrawal of the objection to claim 5.

The Examiner next objected to claim 10 stating that "there is a lack of antecedent basis in the specification for the housing having one annular ring, as stated by 'at least one' ring in line 4" and that "[a]s claimed, claim 10 appears to state that the pair of collets is coupled to one ring." Applicant has amended claim 10 to clarify that which is called for therein. As amended, claim 10 calls for, in part, a housing having a pair of annular rings and a pair of collets wherein each collet is rotatably coupled to a respective annular ring. As such, Applicant requests the objection to claim 10 be withdrawn. Additionally, as the Examiner states that "claims 10-15 ... would be allowable if rewritten to overcome the objections...", Applicant believes claims 10-15 are in condition for allowance.

The Examiner next objected to claim 28 stating that "there is lack of antecedent basis in the specification for the housing having one annular lip, as stated by 'at least one' lip in line 9" and that "[a]s claimed, claim [28] [[10]] appears to state that the pair of collets is coupled to one lip." Applicant has amended claim 28 to clarify that which is called for therein. As amended, claim 28 calls for, in part, a housing having a pair of annular lips and a pair of collets wherein each collet is rotatably coupled to a respective annular lip. Applicant therefore requests the withdrawal of the objection to claim 28.

The Examiner next objected to claim 29 stating that "there is lack of antecedent basis in the specification for the connector having one collet, as stated by 'at least one' collet in line 9" and that "[t]he specification and figures disclose that there are two collets." It is apparent that the Examiner is reading limitations into the claims from the specification but none-the-less, as the Examiner acknowledges that the specification and

INVENTOR: Desai et al.

S/N 09/682,843

figures show two collets, and two collets necessarily include at least one collet as called for in claim 29, there is no lack of antecedent basis for such a limitation. Accordingly, Applicant requests the objection to claim 29 be withdrawn.

The Examiner next objected to claim 30 stating that "there is lack of antecedent basis in the specification for only one of the sticks having a ridge, as stated by 'at least one' stick in line 8" and that "[t]he specification and figures disclose that both sticks have a ridge." Yet again, by showing that both sticks having a ridge necessarily means that at least one of the sticks is disclosed as having a ridge. Accordingly, there is not a lack of antecedent basis in the specification or figures for at least one of the sticks having a ridge as called for in claim 30. Applicant therefore requests the objection to claim 30 be withdrawn. Therefore, as the Examiner states that "claims ... 28-30 would be allowable if rewritten and amended to overcome the objections..." Applicant believes claims 28-30 are in condition for allowance.

The Examiner next rejected claims 1, 3, 4, 7-9, 16-24, 26, and 31 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of Lundberg, Sr. et al., and further in view of Peterson. Applicant appreciates the discussion with the Examiner prior to submission of the draft amendment clarifying the Examiner's position that the prior art devices can "advance" by way of gravity (i.e. held in a downward manner, the prior art devices will allow the still to fall out.).

Applicant has amended claim 1 to call for, in part, a pair of extension mechanisms extending from a connector and constructed to independently and proportionally advance each of the indicator sticks upon rotation of the respective extension mechanism. That is, upon rotation of the respective extension mechanism, the indicator stick associated therewith is independently and proportionally advanced from the connector. There is no disclosure in the art of record for such an advancement mechanism. It is apparent that the holders of each of OMEGAMARKER®, Lundberg Sr. et al (Fig. 2), and Peterson (Fig. 2) each require the holders to be rotated from a generally horizontal position to allow the writing instrument positioned therein to be advanced from the holders only by an operator physically grabbing the writing instrument or by rotating the housing such that gravity allows the writing instrument to fall therefrom. That is, advancement of the

INVENTOR: Desai et al.

S/N 09/682,843

writing instruments in the art of record is not proportional to the rotation of the respective retention means disclosed therein but is proportional to the degree from horizontal to which the holder is rotated. Simply, each of the references requires an operator to loosen the retention means positioned about the respective writing instrument positioned in the holder and then either manually position the writing instrument in the holder so a desired length extends therefrom or manually tip the holder and catch the writing instrument as it falls therefrom.

As stated in Lundberg Sr. et al.:

When it is desired to project one of the pieces of chalk or crayon to operative or writing position, the end of the holder containing such piece is turned downwardly and the adjacent coil spring is rolled upwardly toward the band 14 by a thumb or finger. This permits gravity to draw the piece of chalk or crayon downwardly through the enlarged opening between the ends or the fingers. When the piece of chalk or crayon projects from the fingers the desired distance, the coil spring is released whereupon it immediately snaps back into engagement with the flanges of the fingers and locks the piece of chalk or crayon in the desired position. In effecting such movement of a piece of chalk or crayon from retracted to operative position, it is usually desirable to position a finger or other obstruction beneath the lowered end of the holder to stop downward movement of the chalk or crayon in the desired position, whereupon the coil spring is released to lock the chalk or crayon in this position.

Col. 2, ln. 71 to col. 3, ln. 16.

That is, a finger or obstruction must be applied to control the movement of the respective writing instrument from the holder of Lundberg Sr. et al.. A similar construction is also shown in Peterson. That is, as shown in Figs. 1 and 2 of Peterson, once clamping ring (5) is loosened about fingers (3), crayon C must be gripped by an operator or shell (1) must be tipped to allow crayon C to move relative thereto. That is, due to the uncontrolled gravitational advancement of the writing instrument, a finger or other objection must be applied to prevent the writing instrument from falling from the holder. As such, "advancement" of the writing instrument is not proportional to the rotation of the extension mechanism as called for in claim 1, but is allowed to advance therefrom at a speed dependant on the degree of rotation of the holder from a horizontal position to a vertical position. As such, that which is called for in claim 1 is not taught,

INVENTOR: Desai et al.

S/N 09/682,843

suggested, or disclosed in the art of record. Accordingly, Applicant believes claim 1, and those claims that depend therefrom, are patentably distinct over the art of record.

Claim 16 has been amended to call for wherein rotation of a respective advancing means extends a corresponding indicating means in a controlled manner from the retaining means. As previously argued with respect to claim 1, each of the retention means in the art of record requires an operator to loosen the respective retention means and rotate the holders disclosed therein in order to allow gravity to "advance" the writing implement positioned therein. Additionally, if the retention means of any of the holders of the art of record are loosened when the holder is in a vertical position, as soon as the gravitational force exerted on the writing instrument overcomes the frictional force between the writing instrument and the holder, the writing instrument will fall freely therefrom. As such, rotation of any of the "advancing" means of the holders shown in the art of record does not extend the writing instruments in a controlled manner from the holder. As Lundberg Sr. et al. discloses, a finger or other obstruction should be used to control the advancement of the writing instrument from the holder. Accordingly, as the art of record does not teach, suggest, or disclose rotation of a respective advancing means that extends a corresponding indicating means in a controlled manner from a retaining means as called for in claim 16, Applicant believes claim 16, and those claims that depend therefrom, are patentably distinct over the art of record.

The Examiner also rejected claim 22 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of Lundberg, Sr. et al., and further in view of Peterson. Applicant has amended claim 22 to call for, in part, a first and a second extension mechanism connected to a single assembly and constructed to engage and extend a first and a second indicator sticks from the assembly upon rotation of the respective extension mechanism. That is, the extension mechanisms not only extends the indicator sticks but also engages the indicator sticks. The art of record does not teach, suggest, or disclose an extension mechanism that engages the writing instruments positioned in the single assembly as called for in claim 22. Simply, each of the references of the art of record includes a portion of the holder positioned between the "extension" means and the writing instrument positioned therein. As such, that which is

INVENTOR: Desai et al.

S/N 09/682,843

called for in claim 22 is not taught, suggested, or disclosed in the art of record. Accordingly, Applicant believes claim 22, and those claims that depend therefrom, are patentably distinct over the art of record.

The Examiner rejected claim 31 under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® in view of Lundberg, Sr. et al., and further in view of Peterson. Applicant has amended claim 31 to call for, in part, a dual temperature indicator stick having an extension member constructed to extend and retract a respective indicator stick housed therein in a controlled manner by rotation relative thereto. As previously argued with respect to claim 16, each of the holders of the art of record requires the retaining structure to be loosened prior to movement of the respective writing instrument. Merely loosening the retaining means does not extend or retract the writing instrument positioned therein. The writing instrument must be grabbed or the entire holder tipped so that the writing instrument can be slid out of, or into, the holder. That is, rotation of the retaining means in each of the references does not extend or retract the writing instruments positioned therein but merely allows the writing instrument to be secured within the holder or to freely move therein. That is, gravity must be used to advance the writing instruments positioned in the holders of the art of record. As disclosed in Lundberg Sr. et al., a finger or other obstruction must be used to "control" the advancement of the writing instrument from the housing. That is, without the finger or obstruction, the writing instrument would fall freely entirely out of the holder. Such is surely not a "controlled manner" as called for in claim 31. As such, the art of record does not teach, suggest, or disclose that which is called for in claim 31. Accordingly, Applicant believes claim 31 is patentably distinct over the art of record.

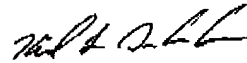
Therefore, in light of the foregoing, Applicant respectfully believes that each of the claims of the present application is patentably distinct over the art of record. Accordingly, Applicant believes the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-24 and 26-32.

INVENTOR: Desai et al.

S/N 09/682,843

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Kirk L. Deheck  
Registration No. 55,782  
Direct Dial 262-376-5170 ext. 16  
[kld@zpspatents.com](mailto:kld@zpspatents.com)

Dated: October 4, 2004.  
Attorney Docket No.: ITW7510.006

**P.O. ADDRESS:**  
Ziolkowski Patent Solutions Group, LLC  
14135 North Cedarburg Road  
Mequon, WI 53097-1416  
262-376-5170

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**